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In re Application of
LENTING et al.
Application No.: 09/831,679
PCT No.: PCT/AT99/00272
Int. Filing Date: 10 November 1999
Priority Date: 10 November 1998
Attorney Docket No.: 20560-32
For: FACTOR VIII POLYPEPTIDE HAVING
FACTOR VIII:C ACTIVITY

: NOTIFICATION AND
:
: DECISION ON
:
: PETITION UNDER
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: 37 CFR 1.137(b)
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:

This decision is in response to the "PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)" filed 05 July 2001.

BACKGROUND

On 10 November 1999, applicants filed international application PCT/AT99/00272, which claimed a priority date of 10 November 1998. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 18 May 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 06 June 2000, which was within nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 10 May 2001.

On 10 May 2001, applicants filed, *inter alia*, a transmittal letter concerning a filing under 35 U.S.C. 371 (Form PTO-1390) and a "translation"¹ of the international application into English. The transmittal letter was not accompanied by a check or by an authorization to charge a Deposit Account for the Basic National fee.

On 13 June 2000, the USPTO mailed a NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) indicating that the application was abandoned as to the United States of America for failure to provide the full U.S. Basic National Fee by thirty months.

¹ It is noted that this "translation" does not appear to be a translation of the international application as filed. For example, it contains a different number of claims than the published international application.

On 05 July 2001, applicants filed the instant "PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)".

DISCUSSION

Conflicting Instructions

Any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). The official PTO Notice published in the Official Gazette at 1077 OG 13 entitled "Minimum Requirements for Acceptance of Applications Under 35 U.S.C. 371 (the National Stage of PCT)" states, in part, the following:

The Patent and Trademark Office is continuing to receive application papers which do not clearly identify whether the papers (1) are being submitted to enter the national stage of the Patent Cooperation Treaty (PCT) under 35 U.S.C. 371 or (2) are being filed as a regular national application under 35 U.S.C. 111.

* * *

If there are any conflicting instructions as to which sections of the statute (371 or 111) is intended the application will be accepted under 35 U.S.C. 111.

The transmittal letter (Form PTO-1390) filed on 10 May 2001 identified the application as "a filing under 35 U.S.C. 371." However, the first paragraph of the "translation" of the international application filed 10 May 2001 states that "[t]his application claims priority to . . . PCT application WO00/28021" Applicant's reference to the disclosure as claiming priority to the international application in the first sentence of the specification is inconsistent with the transmittal letter filed 25 June 1999 and contradicts the request in the transmittal letter to file under 35 U.S.C. 371. See, e.g., MPEP 1893.03(c) ("a national stage application filed under 35 U.S.C. 371 may not claim benefit of the filing date of the international application of which it is the national stage since its filing date is the date of filing of that international application"). The transmittal letter (Form-1390) used by applicant is to be used only with submissions under 35 U.S.C. 371. Since applicant gave conflicting instructions, the papers should have been considered as having been filed under 35 U.S.C. 111(a). Accordingly, the original papers deposited on 10 May 2001 were improperly accepted as a submission under 35 U.S.C. 371. The NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) mailed 13 June 2001 is hereby VACATED. The application is deemed to have been filed under 35 U.S.C. 111(a).

Continuation Application

Applicant is entitled to claim benefit under 35 U.S.C. 120 and 365(c) of the filing date of the international application for the common subject matter, since this application (Serial No.

09/831,679) and the international application (PCT/AT99/00272) designating the United States were copending on 10 May 2001.

Applicant is reminded that in order to perfect the claim for priority under 35 U.S.C. 119, applicant must submit certified copies of the priority documents. The certified copies of priority documents submitted to the International Bureau cannot be relied upon to perfect the claim for priority. See MPEP § 1896.

Petition to Revive

Because the filing of the present continuing application under 35 U.S.C. 111(a) on 10 May 2001 is accepted as an appropriate response and the application was not filed under 35 U.S.C. 371, the U.S. Basic National Fee was not due on 10 May 2001. Accordingly, the petition to revive under 37 CFR 1.137(b) is moot. The petition fee of \$1,240 will be credited to Deposit Account No. 16-2230.

CONCLUSION

The petition under 37 CFR 1.137(b) is DISMISSED as MOOT for the reasons set forth above.

The NOTIFICATION OF ABANDONMENT mailed 13 June 2001 is VACATED.

This application is accepted as an application filed under 35 U.S.C. 111(a) with a filing date of 10 May 2001.

Please direct any further correspondence with respect to this matter to the Commissioner of Patents and Trademarks, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the Office of PCT Legal Administration.

This application is being forwarded to the National Stage Processing Branch of the International Division for processing in accordance with this decision, that is for (1) removal of the papers communicated from the International Bureau to the United States Patent and Trademark Office concerning international application PCT/AT99/00272, (2) correction of information in PALM (computer database) and (3) correction of fees. Afterwards, the application will be forwarded to the Office of Initial Patent Examination for processing as a national application filed under 35 U.S.C. 111(a) with a filing date of 10 May 2001.



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